

REMARKS

The office action together with the references cited therein have been carefully considered in connection with the application and amendments have been made to claim 11 to incorporate the subject matter of claim 14 and to correct the dependency of claim 13. Claims 12 and 14 have been cancelled, without prejudice.

The examiner has rejected claims 1-4 and 8-10 under 35 U.S.C. 103(a) as being unpatentable over Maier in view of Anderson. The examiner has also rejected claim 6 based upon the combination of Maier in view of Anderson and further in view of Wu and Dukess. The examiner has also rejected claim 7 as being unpatentable over Maier in view of Anderson and further in view of Rubley. The examiner has also rejected claims 1-4, 8-9 and 11-13 under 35 U.S.C. 103(a) as being unpatentable over Kopras in view of Anderson and has rejected claim 6 as being unpatentable over Maier in view of Kopras and further in view of Wu and Dukess and has rejected claim 7 as being unpatentable over Maier in view of Kopras and further in view of Rubley.

In the examiner's response to applicant's arguments, the examiner has totally ignored the argument that the examiner has improperly reconstructed the subject matter of these claims based upon a combination of three or four or more patents as well as other instances of using "old" features without citation to any prior art. Additionally, further modifications are required to several of the cited patents and there is no motivation for the combinations or the modifications to the combinations except for the vague, conclusory statements that "it would have been obvious to one of ordinary skill in the art" to do so.

The examiner has clearly used improper hindsight reconstruction to reject these claims. There are many decisions of the Court of Appeals for the Federal Circuit that have held such reconstruction as being improper. *In re Lee* establishes that it is improper to make an obviousness determination by substituting the "common knowledge" of one skilled in the art for specific evidence that the prior art suggests an invaliding combination of references. It is impermissible error for the Court to use

hindsight to reconstruct the claimed invention from prior art with the aid of an expert rather than viewing it from the position of one of ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51 (Fed. Cir. 1988). When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990).

Not only is there a lack of motivation to combine *any* of the cited references that are relied upon by the examiner, the examiner admits that the references themselves need to be modified as part of the combination. Not only that, the examiner states that it would have been obvious to one of ordinary skill in the art at the time that the invention was made to provide a lens taught by Wu on the modified device of Maier, the examiner states that the lens itself had to be modified to employ a lighting assembly as taught by Anderson. It is submitted that there is no motivation supplied by any of these references to combine them with the others, and there is no motivation to modify them in the manner suggested. It can only be done as a result of using the applicant's claims as a roadmap to locate features that purportedly meet the claims.

Applicant continues to believe that claim 1 is not taught or suggested by Maier or Anderson, or the other references of record, applied singularly or in combination with one another. The examiner states that Maier shows an *attachment* for a power driven wrench. It is still believed that this is a mischaracterization of what is disclosed in Maier inasmuch as it is not an attachment but is in fact a power driven wrench. It is clearly a tool as opposed to an attachment for a tool and it is driven by being connected to a source of positive air pressure.

Anderson is similarly a pneumatic power driven tool that is driven by a source of positive air pressure and it too is a tool rather than an attachment for a tool. The examiner states that Anderson shows a generator and light for a power tool similar to that of Maier and that "obviously one of ordinary skill in the art would add such a light to

the device of Maier.” It is believed that this statement is largely irrelevant for the reason that adding a light to Maier still does not teach or suggest a right angle *attachment* for a power hand tool as is claimed. It is also a conclusory statement that is not supported by any reference to prior art and is therefore believed to be improper.

Neither Maier nor Anderson discloses an attachment for a power hand tool wherein the attachment has the structure as claimed. The examiner also states that “lenses are old and such lighting would be obvious to use with such a device.” This is also not supported by any prior art and is also therefore improper. Similarly, the examiner states that driving a saw in place of a drill is old and would be obvious to add to the Maier device to increase its versatility. However, this is again a conclusory statement that is not supported by any prior art and the Maier patent specifically states that it is a wrench. The examiner also states that compression band mountings are old and would be a mechanical equivalent to the threads of Maier. This is another conclusory statement that is not supported by any reference to prior art and is therefore also improper.


What is clear from the examiner’s statements is that neither Maier or Anderson disclose an *attachment* for a power tool, which is what applicant claims in claim 1. Neither Maier nor Anderson teach or suggest a lens in the housing adjacent said light producing device for admitting light to the exterior of said housing toward a tool attached to said distal end. Neither Maier nor Anderson teach or suggest a housing having a mounting end and a distal end with the mounting end having a cylindrical opening sized to snugly fit on the nose end portion of the tool housing. Neither Maier nor Anderson teach or suggest a housing having an input shaft journaled in bushings and having an engaging recess at one end portion for engaging a drive shaft that is driven by the motor output shaft and an attached gear at the opposite end.

The dependent claims necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and are therefore believed to be in condition for immediate allowance.

For the foregoing reasons, reconsideration and allowance of all claims presently pending in the application is respectfully requested.

Respectfully submitted,

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